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08/983,605	05/01/98	RODER	M 2936.104/00

EXAMINER

HM12/0409

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ART UNIT

PAPER NUMBER

18

DATE MAILED: 1638

04/09/01

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

See attached sheets.

Art Unit: 1638

## **DETAILED ACTION**

### ***Non-Responsive Amendment***

1. The amendment filed on January 29, 2001 canceling all claims drawn to the elected invention and presenting only claims drawn to a non-elected invention is non-responsive (MPEP § 821.03). The newly submitted claims are not readable on the elected invention because these claims are directed to a method of genotyping plants, classified in class 800, subclass 423. As set forth in the previous Office action, the cancelled claims were directed to microsatellite markers and methods of making said markers, classified in class 536, subclass 24.3. Applicant elected to prosecute Group I, identified to be directed to SEQ ID Nos: 1-20. The new invention covered by the new claims is independent and patentably distinct from the inventions previously presented. The new invention is related to the previous inventions as process of use of the product inventions. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the markers may be used for the insertion and verification of insertion of a heterologous sequence into a plant genome. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and the literature and sequence search required for the process is not required for product, restriction for examination purposes as indicated is proper.

Application/Control Number: 08/983605

Page 3

Art Unit: 1638

Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR

1.136(a) ARE AVAILABLE.

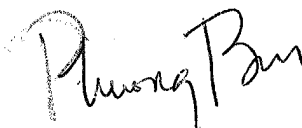
2. Papers relating to this application may be submitted to Technology Sector 1 by facsimile transmission. Papers should be faxed to Crystal Mall 1, Art Unit 1638, using fax number (703) 308-4242. All Technology Sector 1 fax machines are available to receive transmissions 24 hrs/day, 7 days/wk. Please note that the faxing of such papers must conform with the Notice published in the Official Gazette, 1096 OG 30, (November 15, 1989).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong Bui whose telephone number is (703) 305-1996. The Examiner can normally be reached Monday-Friday from 6:30 AM - 4:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is (703) 308-0196.

Phuong Bui  
Primary Examiner  
Group Art Unit 1638  
April 3, 2001

  
PHUONG T. BUI  
PRIMARY EXAMINER